REMARKS

Claims 1-10 and 12-30 were pending in this application.

Claims 1-10 and 12-30 have been rejected.

No claims have been amended.

Reconsideration and full allowance of Claims 1-10 and 12-30 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

Claims 1-3, 5, 18-19, 24-25, and 30 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,220,629 to Kosaka et al. ("*Kosaka*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Claims 1, 18, and 24 recite counting "syllables in each word of [a] text segment" and assigning a "playing rate indicator" to each word "based on a total number of syllables in said word."

Kosaka recites a speech synthesis apparatus and method. (*Abstract*). The apparatus includes a power controller for normalizing a vowel-consonant-vowel (VCV) speech segment so

that the power at both ends of the segment coincides with the average power of each vowel. (*Abstract*). In general, the start of a sentence or word has a higher power, and the power is gradually reduced toward the end of the sentence or word. (*Col. 8, Lines 40-42*). This can be determined using the number of syllables in the sentence or word. (*Col. 8, Lines 42-45*). The apparatus also includes "parameter expansion/reduction rate setting means" for setting an "expansion/reduction rate" for VCV parameters. (*Col. 12, Lines 55-59*). The expansion/reduction rate is larger for a vowel, the letter "S," and the letter "F" and smaller for explosive consonants such as "P" and "T." (*Col. 12, Lines 59-64*). The parameters are expanded or reduced to coincide with a "syllable beat point pitch," where the syllable beat point pitch is determined using a method described with reference to Figure 19 of *Kosaka*. (*Col. 13, Lines 1-10*).

The Office Action asserts that *Kosaka* anticipates counting syllables by reciting that the power of a word or sentence may be based on the number of syllables in the word or sentence. (*Office Action, Page 2, Last paragraph*). The Office Action also argues that *Kosaka* anticipates assigning a playing rate indicator to words based on the total number of syllables in the words by reciting that VCV parameters are expanded or reduced to coincide with syllable beat point pitches. (*Office Action, Page 2, Last paragraph*).

The Office Action fails to show that the total number of syllables used to determine the power of a word or sentence is later used to expand or reduce the VCV parameters in *Kosaka*. While *Kosaka* may, arguably, count syllables in a word or sentence and base a power on that syllable count, the Office Action fails to show that *Kosaka* uses the same syllable count to

expand or reduce the VCV parameters. In fact, *Kosaka* clearly states that the VCV parameters are expanded or reduced using syllable beat point pitches, which are determined using the method described "with reference to FIG. 19." (*Col. 13, Lines 9-10*). In the description of Figure 19, *Kosaka* does not disclose using a syllable count to determine the syllable beat point pitches. (*Col. 13, Lines 23-63*).

In effect, the basis for the current rejection is that *Kosaka* discloses counting syllables and expanding or reducing VCV parameters without showing that the second function is based on the results of the first function. Because of this, the Office Action fails to show that *Kosaka* anticipates counting "syllables in each word of [a] text segment" and assigning a "playing rate indicator" to each word "based on a total number of syllables in said word" as recited in Claims 1, 18, and 24.

For these reasons, *Kosaka* fails to anticipate all elements of Claims 1, 18, and 24 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 1-3, 5, 18-19, 24-25, and 30.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kosaka* in view of U.S. Patent No. 5,384,893 to Hutchins ("*Hutchins*"). Claims 6-7, 20-21, and 26-27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,396,577 to Oikawa et al. ("*Oikawa*") in view of U.S. Patent No. 5,146,405 to Church ("*Church*"). Claims 8-10 and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oikawa* and

Church in further view of *Hutchins*. Claims 13-14, 22-23, and 28-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oikawa* in view of U.S. Patent No. 5,924,068 to Richard et al. ("*Richard*"). Claims 15-17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oikawa* and *Richard* in further view of *Hutchins*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of

obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Regarding Claim 4, Claim 4 depends from Claim 1. As described above in Section I, Claim 1 is patentable over *Kosaka*. For these reasons, Claim 4 is patentable due to its dependence from an allowable base claim.

Claims 6, 20, and 26 recite performing a "grammatical analysis of [a] text segment" and assigning a "playing rate indicator" to each word of the text segment "based on said grammatical analysis."

Oikawa recites a speech synthesizing apparatus. (*Abstract*). The apparatus associates portions of original text with "importance degree information." (*Abstract*). The importance degree information identifies the importance of each portion of the original text. (*Abstract*). Based on the speed at which the original text is to be read, a portion of the original text may be skipped depending on the importance degree information for that portion. (*Abstract*).

Oikawa simply recites associating an importance degree value with each portion of original text. However, *Oikawa* fails to disclose, teach, or suggest associating an importance degree value with each word in the original text. As a result, *Oikawa* fails to disclose, teach, or

suggest assigning a playing rate indicator to "each word" of a text segment as recited in Claims 6, 20, and 26.

In addition, the importance degree values of *Oikawa* do not identify a rate at which a portion of text is played. Instead, the importance degree values allow *Oikawa* to skip portions of text. As a result, *Oikawa* fails to disclose, teach, or suggest assigning a "playing rate indicator" to each word of a text segment as recited in Claims 6, 20, and 26.

The Office Action cites *Church* only as disclosing analysis of text to identify "parts of speech," which are then used to synthesize speech. (*Office Action, Page 6, Third paragraph*). The Office Action does not rely on *Church* as disclosing, teaching, or suggesting assigning a "playing rate indicator" to "each word" of a "text segment" as recited in Claims 6, 20, and 26.

For these reasons, the Office Action has failed to show that the proposed *Oikawa–Church* combination discloses, teaches, or suggests all elements of Claims 6, 20, and 26. As a result, the Office Action has failed to establish a *prima facie* case of obviousness against Claims 6, 20, and 26 (and their dependent claims).

Claims 13, 22, and 28 recite comparing "each word of [a] text segment to an inventory of pre-selected words" and assigning a "playing rate indicator" to each word "based on said comparison."[a]

The Office Action acknowledges that *Oikawa* fails to disclose assigning a "playing rate indicator" to "each word" of a "text segment" based on a comparison of each word to "an

[a] Initially, the Applicant notes that the Office Action may have misinterpreted the elements of Claims 13, 22, 28. In particular, when rejecting these claims, the Office Action asserts that *Oikawa* anticipates "performing analysis of said text segment." (*Office Action, Page 9, First paragraph*). However, Claims 13, 22, and 28 do not recite "performing analysis of said text segment."

inventory of pre-selected words." (*Office Action, Page 9, Third paragraph*). In fact, *Oikawa* fails to disclose, teach, or suggest assigning a playing rate indicator to each word of a text segment on any basis. As described above, the importance degree values of *Oikawa* allow the apparatus of *Oikawa* to skip portions of text and do not actually identify a rate at which a portion of text is played. As a result, *Oikawa* lacks any mention of assigning a "playing rate indicator" to each word of a text segment as recited in Claims 13, 22, and 28.

In addition, the Office Action fails to provide a valid motivation for modifying *Oikawa* with the recitations of *Richard*. *Richard* recites an apparatus for reading newspaper articles to a user. (*Abstract*). The apparatus receives dictionary addresses representing words in a dictionary, and the apparatus accesses the dictionary and reads the words at those addresses to the user. (*Abstract*). The user can control the rate at which the articles are read and provide keywords that are used to select which articles are read. (*Abstract*).

The Office Action asserts that a person skilled in the art would be motivated to combine *Oikawa* and *Richard* because it would allow "system users to determine what text is synthesized and vary the rate at which the synthetic speech is produced." (*Office Action, Page 9, Fifth paragraph*). The cited portion of *Richard* recites that keywords are used to select newspaper articles and a dictionary is used to locate and read words in the articles to a user. The cited portion of *Richard* fails to mention that the dictionary or keywords are used to "vary the rate at which the synthetic speech is produced." Also, the cited portion of *Richard* fails to mention that the dictionary is used to determine "what text is synthesized." Further, even if *Oikawa* was modified Initially, the Applicant notes that the Office Action appears to interpret these claims

improperly. In particular, when rejecting these claims, the Office Action asserts that *Oikawa* anticipates "performing analysis of said text segment." (*Office Action, Page 9, First paragraph*). However, Claims 13, 22, and 28 do not recite "performing analysis of said text segment."

to support the use of keywords, both references still fail to disclose, teach, or suggest assigning a rate at which a word is played based on whether the word is a keyword.

For these reasons, the Office Action has failed to establish that a person skilled in the art would combine *Oikawa* and *Richard*. Further, the proposed *Oikawa–Richard* combination fails to disclose, teach, or suggest all elements of Claims 13, 22, and 28. As a result, the Office Action has failed to establish a *prima facie* case of obviousness against Claims 13, 22, and 28 (and their dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections and full allowance of Claims 4, 6-10, 12-17, 20-23, and 26-29.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the claims in this application are in condition for allowance and respectfully requests an early allowance of such claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***rmccutcheon@davismunck.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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Date: 4/5/2004

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